

Application No.: 10/073,040**Docket No.: 1553-017****REMARKS**

Applicants appreciate the Examiner's thorough review of the present application, and respectfully request reconsideration in light of the preceding amendments and the following remarks.

Claims 7-13 and 15-27 are pending in the application. Independent claims 7, 18 and 22 have been amended to better define the claimed invention. New claims 25-27 have been added to provide Applicants with the scope of protection to which they are believed entitled. No new matter has been introduced through the foregoing amendments.

The 35 U.S.C. 103(a) rejection of claims 7-13 and 15-24 as being obvious over FIG. 5D of *Tayebi* (U.S. Patent No. 5,989,667) is noted. Basically, the Examiner argued that it would have been obvious to vary the number and widths of both adhesive and adhesive-free areas in FIG. 5D of *Tayebi* through optimization to arrive at the claimed invention, because the reference suggests that the number, lengths, widths and shapes of the areas can be changed. Applicants respectfully disagree with the Examiner's position.

First, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *See MPEP*, section 2143.01 quoting *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Thus, the arguable fact that *Tayebi* teaches the number, lengths, widths and shapes of the areas can be changed does not render the claimed number and widths of the areas obvious.

Second, a particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977) discussed in *MPEP* section 2144.05. II. B (emphasis added). Thus, the Examiner's optimization argument might be proper only if the art, prior to the present

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invention, has recognized the claimed number and widths of the areas as result-effective variables, i.e., variables which achieve recognized results.

Applicants note the Examiner's allegation that the passage found at column 3, line 55 through column 4, line 7 of *Tayebi* explains how the widths of the adhesive areas effect the overall releasability of the sheet as well as how the sheet is separated for use. However, the cited passage of *Tayebi* does not provide such explanation. For example, column 3, lines 55-65 of *Tayebi* discloses various configurations of weakened lines 10 and 12 which are believed irrelevant to the rejected claims. Further, column 3, line 65 through column 4, line 3 of *Tayebi* discloses various positions and shapes of the adhesive area 8, without specifying whether the width of the adhesive area 8 provides any recognized results. Finally, column 4, lines 4-7 of *Tayebi* discloses that multiple adhesive or adhesive-free areas of the same of different shapes can be used in a single sticker, without specifying whether the number of the adhesive and adhesive free areas 8 provide any recognized results. Accordingly, Applicants respectfully submit that *Tayebi* as applied by the Examiner has failed to show that the number and widths of adhesive and adhesive-free areas can be regarded as optimizable, and hence, the rejection as formulated by the Examiner is inappropriate and should be withdrawn.

Solely for the purpose of expediting prosecution, further claim amendments have been made to further define the claimed invention over the applied reference.

Amended independent claim 7 now recites among other things that the sheet material is free of weakened regions. This amendment finds solid support in the application as filed, e.g., FIGs. 1, 3A and 3B, where the sheet material 10/51 is disclosed to be free of weakened regions. *Tayebi* clearly fails to disclose, teach or suggest the newly added limitation because the sticker of *Tayebi* must have a weakened tear line (10) or score line (12) which is the primary point of novelty disclosed by *Tayebi*. See Abstract; column 1, lines 23 and 34; and column 3, lines 27 and 38 of *Tayebi*. Modifying the reference to remove the weakened tear line or fold line would render the

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reference unsatisfactory for its intended purpose of overcoming the reference's prior art disadvantages. See column 2, lines 31-48 of *Tayebi*. Accordingly, amended claim 7 is patentable over *Tayebi*.

Claims 8-13 and 15-17 and new claim 25 depend from claim 7, and are considered patentable at least for the reason advanced with respect to amended claim 7.

New claim 25 is also patentable on its own merit since the claim recites other features of the invention neither disclosed, taught nor suggested by the applied art. In particular, new claim 25 requires that the sheet material extends continuously throughout an entirety thereof without disruption and without apparent tear lines or fold lines along which said sheet material can be torn or folded. As can be seen in all figures of *Tayebi*, the stickers of the reference extend with disruptions at the tear or fold lines.

Independent claim 18 now recites among other things that the major surfaces are substantially parallel with each other throughout an entirety of said sheet material and define a substantially constant thickness of said sheet material throughout said entirety of said sheet material. This amendment finds solid support in the application as filed, e.g., FIGs. 3A and 3B, where the upper and lower surfaces of the sheet material 10/51 are disclosed to be substantially parallel throughout an entirety of the sheet material, and to define a substantially constant thickness of the sheet material. *Tayebi* clearly fails to disclose, teach or suggest the newly added limitation because the sticker of *Tayebi* must have a weakened tear line (10), which is a pre-slit cut line, a perforated line, or a micro-perforated line, and/or a score line (12). Apparently, at such tear or fold lines, either the thickness of the *Tayebi* sticker sheet material changes (i.e., reduces to zero) or the major surfaces of the sheet material cease to be parallel. Accordingly, amended claim 18 is patentable over *Tayebi*.

Claims 19-21 and new claim 26 depend from claim 18, and are considered patentable at

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least for the reason advanced with respect to amended claim 18.

Independent claim 22 now recites among other things that the sheet material has a substantially constant physical strength throughout an entirety thereof. This amendment finds solid support in the application as filed, e.g., FIGs. 3A and 3B, where the sheet material 10/51 is disclosed to be constant in thickness and material, and hence, in physical strength. In contrast, *Tayebi* teaches tear or fold lines where the physical strength of the sticker sheet material is reduced to facilitate tearing or folding the sticker. Accordingly, amended claim 22 is patentable over *Tayebi*.

Claims 23-24 and new claim 27 depend from claim 22, and are considered patentable at least for the reason advanced with respect to amended claim 22.

Each of the Examiner's rejections has been traversed. Accordingly, Applicants respectfully submit that all claims are now in condition for allowance. Early and favorable indication of allowance is courteously solicited.

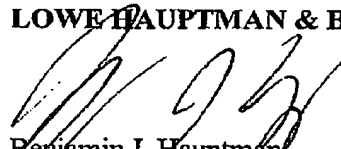
The Examiner is invited to telephone the undersigned, Applicant's attorney of record, to facilitate advancement of the present application.

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To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.


Respectfully submitted,

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